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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,185	10/20/2003	Michael Sweeting	03-6172	2702
63710 7590 01/02/2009 DEAN P. ALDERUCCI CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER				
BASIT, ABDUL				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
01/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,185

Applicant(s)

SWEETING, MICHAEL

Examiner

ABDUL BASIT

Art Unit

3694

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-56 is/are pending in the application.
- 4a) Of the above claim(s) 15-35; 44-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14; 36-43; 54-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 10/20/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 36-43 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 7-14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each claim recites "...due to a cheapest to deliver..." It is unclear as to what the Applicant is referring to that is cheap.

3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims rejected under 35 U.S.C. 102(b) as being anticipated by Nations (US Pub. No. 2002/0138299).

Regarding claim 7 and 36

Nations teaches an apparatus, comprising a processor that:
receives a request to perform a selected one of a buying and a selling operation associated with a futures contract, the futures contract operable to be purchased or sold in a financial market environment, futures contract based at least in part on:
a first asset class having a first value associated therewith; and a second asset class having a second value associated therewith, wherein a price for the futures contract is determined at least partially by the first and second values; and
provides a confirmation notice associated with a sale or a purchase of the futures contract. (see paragraphs 12-13; and 62-64)

Regarding claims 8 and 37

Nations teaches that for the apparatus of Claim 7 or 36, wherein match the processor matches_one or more contract terms provided in the request with an availability associated with the futures contract. *(see paragraphs 12-13; and 62-64)*

Regarding claims 9 and 38

Nations teaches that for the apparatus of Claim 7 or 36, further comprising a memory element that stores a transaction associated with a purchase or a sale of the futures contract. *(see paragraph 89 – use of computers which inherently includes memory)*

Regarding claims 10 and 39

Nations teaches that for the apparatus of Claim 7 or 36, the first asset class representing bonds and the second asset class representing at least one of securities; commodities; and currencies wherein the futures module is operable to confirm a sale or a purchase of the futures contract and to provide a confirmation notification to a selected one of the buyer and the seller of the futures contract. *(see paragraphs 5, 12-13, and 62-64)*

Regarding claim 11 and 40

Nations teaches that for the apparatus of Claim 7 or 36, wherein the futures contract is based at least in part on a third asset class having a third value associated therewith, wherein the first, second, and third values are used at least partially to determine the price. *(see paragraphs 12-13; and 62-64)*

Regarding claim 12 and 41

Nations teaches that for the apparatus of Claim 7 or 36, wherein the processor communicates with a price reporting/dissemination element that is operable to provide financial data to a selected one of the buyer and the seller. *(see paragraphs 12-13 – inherent that financial data is provided to a buyer and/or seller)*

Regarding claim 13 and 42

Nations teaches that for the apparatus of Claim 7 or 36, wherein a change in the first value due to a cheapest to deliver parameter results in a change in the second value. *(see paragraphs 12-13; and 62-64)*

Regarding claim 56

Nations teaches that for the apparatus of Claim 36, the asset class representing a commodity, the first asset subclass representing a first grade of the commodity, and the second asset subclass representing a second grade of the commodity. *(see paragraphs 12-13; and 62-64)*

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14 and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Nations in view of Gershon (US Pat. No. 7,315,838)

Regarding claim 14 and 43

Gershon, not Nations, teaches that for the apparatus of Claim 7 or 36, wherein the futures contract includes a pricing methodology that is based on basis points per annum, the pricing methodology being used at least partially to determine the price for the futures contract. (*see col. 16, lines 35-40*)

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nations with Gershon. Motivation to modify exists, because basis points pricing is a well known method of pricing in the financial industry and allow for reliable pricing information to be communicated between different parties.

7. Claims 54 and 55 rejected under 35 U.S.C. 103(a) as being unpatentable over Nations in view of Pine (US Pat. N o. 7,212,997)

Regarding claims 54 and 55

Pine, not Nations, teaches that wherein the processor determines a settlement price of the futures contract based at least in part on a volume-weighted average price of a plurality of trades associated with the futures contract. (*see col. 19 generally*)

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nations with Pine. Motivation to modify exists, because volume weighted pricing provides for a reliable indication of price based on volume of contracts traded.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABDUL BASIT whose telephone number is 571-272-5506. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ab

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694